

DOCKET NO: 270415US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

:

MAXIMILIAN ANGEL, ET AL.

: EXAMINER: MULCAHY, P. D.

SERIAL NO: 10/532,828

:

FILED: APRIL 26, 2005

: GROUP ART UNIT: 1796

FOR: VINYLACTAM COPOLYMERS  
USED AS GAS HYDRATE INHIBITORS

:

RESTRICTION REQUIREMENT RESPONSE

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

The following is responsive to the Office Action dated January 29, 2008.

Restriction to one of the following inventions has been required under 35 U.S.C.

§ 121:

I. Claims 10-15, 17, 19-21, 28-30, 34 and 36-40, drawn to a method, classified in class 524, subclass various.

II. Claims 18, 25-27, 31-33, 35 and 41-45, drawn to a solution, classified in class 524, subclass 555.

Applicants elect **with traverse** Group II, i.e., Claims 18, 25-27, 31-33, 35 and 41-45.

The Examiner has also required an election of species under 35 U.S.C. §121 as follows:

A. Species of lactam monomer.

B. Species of solvent.

Applicants select N-vinylpyrrolidone as the lactam A, and ethylene glycol as the solvent B, **with traverse.**

Claims 18-21, 25-27, 31, 32, 35, 44 and 45 all read on the elected species.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct (MPEP §803). The burden of proof is on the Examiner to provide reasons and/or examples, to support any conclusion in regard to patentable distinctness (MPEP §803). Applicants respectfully traverse the Restriction Requirement on the ground that the Examiner has not carried the burden of providing any material reasons and/or examples to support the conclusion that the claims of the restricted groups are patentably distinct.

The Examiner has categorized the relationship between the inventions of Group I and Groups II, as mutually exclusive species in intermediate-final product relationship.

In reply, the Examiner is incorrect. Assuming the Examiner treats the solution of Group II as an intermediate product, **no** final product is being claimed. Rather, the relationship between the inventions of Groups II and I is product and process of use, respectively.

A product and a process of using the product can be shown to be distinct inventions if either or both of the following can be shown: (1) the process for using as claimed can be practiced with another materially different product, or (2) the product as claimed can be used in a materially different process. MPEP 806.05 (h). The Examiner has not made the requisite analysis.

Nevertheless, the Examiner's attention is drawn to the following from MPEP §803:

If the search and examination of an entire application can be made without serious burden, the Examiner **must** examine it on the merits, even though it includes claims to distinct or independent inventions. (emphasis added).

Search and examination of the entire application would not appear to impose a serious burden herein. Indeed, as Applicants' attorney pointed out to the Examiner during a telephone conversation on February 4, 2008, the Examiner has already examined the entire application, in view of the First Office Action dated July 5, 2007. Thus, the Examiner cannot possibly now assert a serious burden.

In view of the above, it is respectfully requested that the Restriction Requirement be withdrawn, and that all claims of the application be examined.

Applicants note, with the provisional election of a single species, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. MPEP 803 and 803.02.

Respectfully submitted,

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